Amendment and Response under 37 C.F.R. 1.116
Applicant: Travis J. Parry et al.
Serial No.: 09/756,356
Filed: January 8, 2001
Docket No.: 10002904-1
Title: WIRELESS RETAIL PURCHASING SYSTEM USING A MOBILE COMPUTING DEVICE

REMARKS

The following remarks are made in response to the Final Office Action mailed May 3, 2004. Claims 1-7, 9, 11-15 and 22-24 were rejected. With this response, claim 11 has been canceled, and claims 1 and 23 are amended. Accordingly, claims 1-7, 9, 12-15, and 22-24 remain pending in the application and are presented for reconsideration and allowance.

Claim Rejections under 35 U.S.C. § 103

In the Office Action, claims 1-7, 9, 11-15 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Treyz U.S. Patent No. 6,587,835 (herein Treyz) in view of Pentel U.S. Patent No. 5,969,968 (herein Pentel).

Independent claim 1 specifies a method of wirelessly electronically performing a near-site retail purchase from a drive-up restaurant using a mobile computing device. The method comprises automatically establishing a direct, wireless communication link between the mobile computing device and the drive-up restaurant upon the mobile computing device entering into proximity to the drive-up restaurant to perform the following actions. The method also comprises using this direct wireless link to receive at the mobile computing device from the drive-up restaurant a menu of food items and displaying the menu on a display of the mobile computing device. The method also comprises transmitting from the mobile computing device a purchase request to the drive-up restaurant to purchase at least one food item based on the menu displayed at the mobile computing device. The method also comprises receiving at the mobile computing device from the drive-up restaurant a confirmation of the requested items and displaying the confirmation of the purchase request on the display of the mobile computing device.

Treyz generally discloses a system for providing shopping assistance between retail units and a handheld computing device, and discloses some interactions with restaurants. See Treyz, e.g., Column 42, lines 28-55; Column 43, lines 9-28; Column 65, lines 3-10. However, in the context of drive-up restaurants, Treyz focuses on the use of handheld computing devices for the financial aspects of any transactions (i.e., **payment**) with drive-through restaurants. See Treyz Column 4, lines 1-6; see also, Column 9, lines 28-45; Column 10, lines 9-10, 39-44; Column 18, lines 59-67; see also Column 6, lines 45-60 associated with

Amendment and Response under 37 C.F.R. 1.116
Applicant: Travis J. Parry et al.
Serial No.: 09/756,356
Filed: January 8, 2001
Docket No.: 10002904-1
Title: WIRELESS RETAIL PURCHASING SYSTEM USING A MOBILE COMPUTING DEVICE

Figure 116 ("handheld computing device...used in an automobile for wireless financial transactions . . such as . . . paying for food at drive-through restaurants, etc.") . See also Column 66, lines 1-34 and Figure 117, which appear to emphasize the limited aspect of payment at drive-through restaurants by handheld computing device (step 1102 "use handheld computing device to pay for gas, toll, parking lot fee, food at drive-through restaurant, etc", step 1104 "maintain records of financial transaction" and step 1106 "generate expense report"). See also Figure 118 of Treyz, (and associated text at Column 66, lines 39-68), which focuses generally on the financial exchange between the handheld computing device and the retailer (see Column 66, lines 46-48 "information 1112 on the nature of the financial transaction and the amount of the transaction"), along with more information about traffic, news, promotions and advertisements in addition to the financial transaction (see Column 66, lines 48-68).

Accordingly, in the context of drive-through restaurants, Treyz does <u>not</u> disclose features of Applicant's amended independent claim 1, including receiving at the mobile computing device from the drive-up restaurant a menu of food items and displaying the menu on a display of the mobile computing device, transmitting from the mobile computing device a purchase request to the drive-up restaurant to purchase at least one food item based on the menu displayed at the mobile computing device, and receiving at the mobile computing device from the drive-up restaurant a confirmation of the requested items and displaying the confirmation of the purchase request on the display of the mobile computing device.

Treyz would not be combined with Pentel by one skilled in the art. In other words, one skilled in the art would not use the device of Treyz for drive-up food ordering in the manner disclosed in Pentel. Treyz contemplates an open system in which a consumer with a handheld computing device communicates with a variety of retail establishments, and/or the retail establishments communicate with a variety of handheld computing devices.

In contrast, Pentel apparently contemplates a closed system with an exclusive relationship between a restaurant (or restaurant chain) and a user with an input device. The arrangement apparently creates a dependent relationship in which use of the input device is clearly subservient to the restaurant, and this system is used to foster and perpetuate loyalty between a regular customer and restaurant. In particular, Pentel discloses that the "transportable, hand-held remote devices . . can be assigned to customers who order

Amendment and Response under 37 C.F.R. 1.116
Applicant: Travis J. Parry et al.
Serial No.: 09/756,356
Filed: January 8, 2001
Docket No.: 10002904-1
Title: WIRELESS RETAIL PURCHASING SYSTEM USING A MOBILE COMPUTING DEVICE

frequently from the restaurant. Optimally, the device will have a customer identification which is transmitted with each order so that the restaurant can perform statistical analysis." See Column 1, lines 39-42. The system "allows the restaurant owner to assign a hand-held device to each customer who orders frequently, and to track each customer's ordering habits through a customer identification coded into the device." Column 2, lines 33-36. "Multiple devices may be used, with a separate device being assigned to each customer." Column 3, lines 6-8. A customer identification number is stored in a memory of the input device 12. See Column 3, lines 16-18. Accordingly, Pentel apparently contemplates a closed, limited, dependent interaction between a drive-up restaurant and specifically identified/identifiable customers rather than the situation apparently contemplated in Treyz of generally open interaction between roaming handheld computing devices that are generally independent of a wide variety of retailers, with which they can communicate.

Moreover, in Pentel, the menu is posted on display 36 of ordering station 14 and items available for purchase or sale, are shown on display 36. Items that are ordered are also shown on display 36 of ordering station 14. Neither the menu nor ordered items are shown on input device 14, as input device 14 has _no_ display.

In Pentel, the restaurant apparently has an incentive to limit availability of the menu on display 36 of ordering station 14 (i.e., not to display menu on input device 12). By placing the menu only on the display 36 of ordering station 14, the restaurant apparently draws its customers, via input devices 14, onto the site of the restaurant, making it more likely that that customer will place an order from that restaurant as opposed to some other restaurant (in the case where a menu were generally available on an input device with its own display that can be viewed away from the restaurant). In addition, by handing out input devices 14 to regular customers, the restaurant apparently cultivates loyalty from those customers to that restaurant via preferential treatment of that customer. Meanwhile, the restaurant also apparently expects to leverage that loyalty by tracking that customer's ordering behavior via a unique customer identification number. Accordingly, the restaurant in Pentel apparently uses technology to develop an on-going limited, dependent relationship with the customer – which is created by the restaurant assigning (i.e., giving) the input devices to the customer (to keep with them) to foster the relationship. See Pentel Column 1, lines 39-42; Column 2, lines 33-36; Column 3, lines 16-18.

Amendment and Response under 37 C.F.R. 1.116
Applicant: Travis J. Parry et al.
Serial No.: 09/756,356
Filed: January 8, 2001
Docket No.: 10002904-1
Title: WIRELESS RETAIL PURCHASING SYSTEM USING A MOBILE COMPUTING DEVICE

In contrast, Treyz apparently contemplates a much more general open system in which a consumer is on equal footing with many retailers so that a handheld computing device in Treyz operates non-exclusively with a retailer such as a drive-up restaurant. To apply Treyz to Pentel would disrupt the apparent strategy of a drive-up restaurant in Pentel to use technology in a closed system for cultivating loyalty-based, relatively exclusive relationships between restaurant and its customers.

Accordingly, because Pentel teaches away from the system of Treyz, one skilled in the art would not combine Treyz and Pentel.

Moreover, in the Office Action, it is admitted that Treyz fails to disclose automatically establishing a link between a handheld computing device and a drive-up restaurant. Pentel does not aid Treyz in this deficiency. Rather, Pentel merely discloses the use of RF or IR technology (see Pentel Column 3, lines 36-39), but stops short of disclosing a technology in which a direct wireless link is automatically established upon a mobile computing device entering into proximity of a drive-up restaurant, as claimed by Applicant (supported by Applicant's specification at page 6, lines 13-29). Pentel does not disclose this feature. Accordingly, the Office Action improperly applies hindsight, attributing Applicant's claimed feature (e.g., automatically establishing a wireless link based on the mere presence of the respective devices in proximity) to Pentel. This feature is not necessarily included in all IR technology and is not disclosed explicitly anywhere in Pentel.

In addition, in Treyz, no financial transaction is disclosed in the context of drive-up restaurants in which the purchased food items are listed as part of the financial transaction. In order to pay for items, a consumer only need transmit authorization to pay an amount. Accordingly, making payment does not necessarily include that the items purchased are listed in that payment transfer. One could just as easily make a verbal order of the items from a posted menu, observe a posted order confirmation, and then simply pay with PDA. In the financial transaction, the consumer knows the items being purchased because of the verbal interchange or posted menu. Treyz appears to implicitly disclose that no such information is part of the financial transaction (i.e., payment) for drive-up restaurants since in its discussion of drive-up restaurants, Treyz does not disclose food item information in relation to handheld computing device for drive-up restraints. While Treyz is quite detailed in disclosing the features and item information of other retail environments, Treyz is conspicuously quiet

10

Amendment and Response under 37 C.F.R. 1.116
Applicant: Travis J. Parry et al.
Serial No.: 09/756,356
Filed: January 8, 2001
Docket No.: 10002904-1
Title: WIRELESS RETAIL PURCHASING SYSTEM USING A MOBILE COMPUTING DEVICE

regarding the listing of food items on a handheld computing device in relation to making payment at a drive-up restaurant, i.e., Treyz does not address listing food items as part of a financial transaction with a drive-up restaurant.

Accordingly, Treyz does not positively disclose a listing of ordered food items as part of a financial transaction with a drive-up restaurant and handheld computing device, nor does Pentel.

Even if Treyz listed ordered food items as part of a financial transaction, this would not equate to providing a menu on display of a mobile computing device, prior to the purchase or financial transaction, as claimed by Applicant. The Office Action alludes to "product information" in relation to a "financial transaction." This cited passage in Treyz only very generally disclose a shopping assistance service and that the service could include receiving product information. This cited passage is not discussed in context of drive-up restaurants, and one skilled in the art in reading this passage would not likely associate shopping, shopping services, and product information with ordering food at a drive-up restaurant.

In Pentel keypad 16 of remote device 12 is used to order items from posted visual menu 30 at drive-up ordering station 14 of restaurant. Posted visual menu 30 is separate from remote device 12 and has the description and order number of various food items. See Column 3, lines 23-25. A display 36 is located on ordering station 14, separate from posted visual menu 30, and displays decoded information (e.g. item description and price) from transmitter 24 of remote device 12. See Figure 1a, and Column 3, lines 27-30.

Accordingly, even if Treyz and Pentel were combined, Pentel does not make up for what Treyz lacks. Neither Treyz nor Pentel, in the context of a drive-up restaurant, do not disclose automatically establishing the wireless link, displaying a menu of food items on a mobile computing device, transmitting a purchase request based on the menu displayed on mobile computing device, and receiving and displaying a confirmation of the purchase request on the display of the mobile computing device, as specified in Applicants' amended independent claim 1.

Accordingly, both Treyz and Pentel fail to disclose Applicants' amended independent claim 1. For these reasons, neither Treyz nor Pentel, alone or in combination, anticipate or make obvious Applicant's independent claim 1, which is believed to be allowable. Claims 2-

Amendment and Response under 37 C.F.R. 1.116
Applicant: Travis J. Parry et al.
Serial No.: 09/756,356
Filed: January 8, 2001
Docket No.: 10002904-1
Title: WIRELESS RETAIL PURCHASING SYSTEM USING A MOBILE COMPUTING DEVICE

7, and 9-15 are dependent from amended independent claim 1, and therefore believed to be allowable.

Applicants' amended independent claim 22 specifies a system for identifying and transacting a wireless electronic near-site retail purchase. This system comprises a mobile computing device, a drive-up restaurant, and a direct wireless electronic communication link. The mobile computing device comprises a display and the drive-up restaurant includes a wireless communication module for direct wireless electronic communication with the mobile computing device. The direct wireless electronic communication link between the mobile computing device and the drive-up restaurant is activated automatically between the mobile computing device and the drive-up restaurant upon arrival of the mobile computing device near the premises of the drive-up restaurant. Via the wireless link, the mobile computing device is configured to receive a menu from the drive-up restaurant and display the menu on the display of the mobile computing device, transmit a purchase order of food items to the drive-up restaurant based on the menu displayed on the mobile computing device, receive a confirmation of the purchase order at the mobile computing device from the drive-up restaurant and display the confirmation on the display of the mobile computing device.

Applicants' amended independent claim 23 specifies a wireless purchasing appliance. The appliance comprises a mobile computing device including a display and a wireless communication module configured for automatic local wireless communication with a drive-up restaurant. Via the local wireless communication, the mobile computing device is configured to receive a menu of food items from the drive-up restaurant, display the menu on the display, transmit a purchase request to the drive-up restaurant of at least one food item from the displayed menu, and receive a confirmation of the purchase request which is displayed on the display of the mobile computing device.

Applicants' claims 22 and 23 are patentable over Treyz and/or Pentel for the reasons explained in association with claim 1.

In addition, this claimed system and wireless appliance of claims 22 and 23, respectively, enable a user to make a purchase from a drive-up restaurant without having to be in line-of-sight with any posted menus as required by Pentel, so that an order can be placed before any posted on-site menu 30 and/or display 36 (as in Pentel) is in view. In

Amendment and Response under 37 C.F.R. 1.116
Applicant: Travis J. Parry et al.
Serial No.: 09/756,356
Filed: January 8, 2001
Docket No.: 10002904-1
Title: WIRELESS RETAIL PURCHASING SYSTEM USING A MOBILE COMPUTING DEVICE

Applicants' claims 22 and 23, this feature is made possible by automatic direct wireless communication between the drive-up restaurant and a mobile computing device, displaying a menu of food items from the drive-up restaurant on the mobile computing device, being able to place a purchase request to the drive-up restaurant from mobile computing device based on that menu displayed on mobile computing device, and receiving a confirmation of the purchase request which is also displayed on the mobile computing device.

Neither Treyz nor Pentel disclose these features for a drive-up restaurant as claimed by Applicant in claims 22 and/or 23. Accordingly, neither Treyz nor Pentel, alone or in combination, anticipate or make obvious Applicant's amended independent claims 22-23. Accordingly, Applicants' amended independent claims 22-23 are also believed to be allowable.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-7, 9, 12-15, and 22-24 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-7, 9, 12-15, and 22-24 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

Amendment and Response under 37 C.F.R. 1.116
Applicant: Travis J. Parry et al.
Serial No.: 09/756,356
Filed: January 8, 2001
Docket No.: 10002904-1
Title: WIRELESS RETAIL PURCHASING SYSTEM USING A MOBILE COMPUTING DEVICE

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either James R. McDaniel at Telephone No. (208) 396-4095, Facsimile No. (208) 396-3958 or Paul S. Grunzweig at Telephone No. (763) 878-0099, Facsimile No. (763) 878-1039. In addition, all correspondence should continue to be directed to the following address:

Hewlett-Packard Company
Intellectual Property Administration
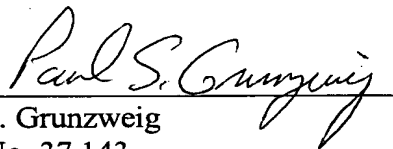P.O. Box 272400
Fort Collins, Colorado 80527-2400

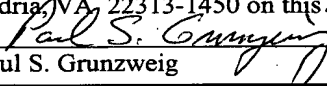Respectfully submitted,

Travis J. Parry et al.,

By their attorneys,

DICKE, BILLIG & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402
Telephone: (763) 878-0099
Facsimile: (612) 573-2005

Date: June 25, 2004
PSG:kle

Paul S. Grunzweig
Reg. No. 37,143

14